

## **REMARKS**

The present Amendment is in response to the Office Action mailed March 3, 2006. Claims 1, 14, and 21 are amended. Claims 1-25 remain pending in view of the above amendments.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **Examiner's Interview**

Applicant's express their appreciation to the Examiner for conducting an interview with Applications on March 28, 2006. This response includes the substance of the interview.

### **Rejections Under 35 U.S.C. § 103**

The Office Action rejected claims 1-2, 5-10, 12-17, 19-22, and 24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,283,761 (*Joao*) in view of U.S. Patent No. 6,343,271 (*Peterson*). Claims 3, 11, and 18 were rejected under *Joao* and *Peterson* and further in view of "Understanding Patient Financial Services" Copyright 1998. Aspen Publishers (*Robinson*). Claim 4 is rejected over *Joao*, *Peterson*, and *Robinson* and further in view of U.S. Patent No. 5,070,452 (*Doyle*). Claim 23 is rejected over *Joao* and *Peterson* in view of *Doyle*. Claim 25 is rejected as being unpatentable over *Joao* and *Peterson* and further in view of U.S. Patent No. 6,738,784 (*Howes*).

Applicant respectfully disagrees. As discussed at the interview and further illustrated in the following remarks, the cited references do not establish a *prima facie* case of obviousness.

One of the fundamental tenets of patent law, when applying 35 U.S.C. § 103, is that the claimed invention must be considered as a whole. *See* MPEP 2141(II). In this case, the Office Action alleges that *Joao* teaches:

- (1) receiving an insurance claim from the client system
- (2) storing an electronic image of the supporting document; and
- (3) notifying the carrier that the electronic image is available via a web server associated with the server system so as to enable the carrier to access the electronic image and process the insurance claim. *See* Office Action at page 3.

At the same time, however, the Office Action notes the *Joao* fails to expressly disclose

- (4) receiving a supporting document associated with the insurance claim in an electronic format from the client system.

In view of the above assertions ((1)-(4)), the Examiner's rejection does not satisfy the *prima facie* requirements of § 103 when considering the claim as a whole. If *Joao*, for example, fails to teach receiving a *supporting document* (4), then it *cannot* teach storing an electronic image of the *supporting document* (2). In other words, the claim requires both receiving an electronic image of a supporting document and storing an electronic image of the supporting document and, when considering the claim as a whole, *Joao* cannot teach storing the electronic image of the electronic document as alleged by the Examiner when it fails to teach receiving the electronic image of the supporting document as noted in the Office Action.

The Examiner further asserts that *Joao* teaches notifying the carrier that the electronic image is available via a web server associated with the server system. The support cited by the Examiner states "[t]he apparatus and method of the present invention can utilize electronic commerce technologies and security methods, techniques and technologies, in any and/or all of the instances of data and/or information processing, and/or data and/or information transmission described herein." *See Joao* col. 4, lines 5-11.

Applicant respectfully disagrees. This paragraph only states that electronic commerce technologies are available, but fails to teach or suggest the requirement of claim 1, namely, notifying the carrier that the electronic image of is available. In other words, *Joao* fails to disclose using these electronic commerce technologies to notify a carrier as required by claim 1.

The Examiner also cited col. 6, lines 45-61 of *Joao* to support the assertion that *Joao* teaches notifying the carrier of the electronic image. As discussed at the interview, however, claim 1 requires both an insurance claim and an electronic image of a supporting document associated with the insurance claim. *Joao* discusses that "patients, providers, . . . [can] file claims with the respective party electronically and/or otherwise." See *Joao* col. 6, lines 45-61. However, the disclosure of filing an insurance claim electronically does not also teach or suggest the electronic image of the supporting document.

Notwithstanding, claim 1 has been amended to further clarify claim 1. Claim 1 as amended requires accessing a database having data indicative of supporting documents associated with insurance claims that are received from client systems once an insurance claim is received. The insurance claim is used to identify a supporting document from the database that is needed to process the insurance claims. Thus, the insurance claim is first received from the client system before a supporting document can be identified from the database. Once the supporting document is identified, it can be received and stored as an electronic image.

As discussed at the interview, the relationship between the insurance claim and the supporting document as required by claim 1 is not found in the cited art. While *Joao* teaches an insurance claim, *Joao* fails to teach a supporting document as required by claim 1. More particularly, no teaching or suggestion is made of the requirement of accessing a database having data indicative of supporting documents associated with insurance claims. Similarly, no teaching or suggestion is made regarding the requirement of identifying a supporting document needed to process the insurance claim from the database based on the insurance claim submitted by the client system as required by claim 1.

As discussed at the interview, the combination of *Joao* and *Peterson* therefore fail to teach or suggest the requirements of claim 1 as set forth in claim 1. For at least the reasons set forth herein and as discussed at the interview, Applicants respectfully submit that claim 1 overcomes the cited art and is in condition for allowance.

Claim 14 similarly requires accessing a supporting document database having a compilation of data indicative of supporting documents and then identifying a particular supporting document needed to process the insurance claim. For at least the reasons discussed above, claim 14 also overcomes the cited art and is in condition for allowance. For at least the

same reasons, the independent claim 21 also overcomes the art of record and is in condition for allowance.

Because the independent claims 1, 14, and 21 overcome the cited art for at least the reasons discussed above, the dependent claim 2-13, 15-20, and 22-25 also overcome the cited art for at least the same reasons.

### **Conclusion**

In view of the foregoing, and consistent with discussions held during the Examiner Interview, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 3<sup>rd</sup> day of July, 2006.

Respectfully submitted,



CARL T. REED  
Registration No. 45,454  
Attorney for Applicant  
Customer No. 022913  
Telephone: (801) 533-9800